

Notice of Allowability	Application No.	Applicant(s)	
	09/759,207	PECKER ET AL.	
	Examiner	Art Unit	
	DiBrino Marianne	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicant's amendment filed 10/4/05 and the Power of Attorney filed 11/17/05.
2. ☒ The allowed claim(s) is/are 26-37.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| <ol style="list-style-type: none"> 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>attached hereto</u>. 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____. |
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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/4/05 has been entered.

2. Applicant's petition filed 9/3/02 under 37 CFR 1.84(a)(2) to Accept Color Drawings/Photographs is HEREBY GRANTED.

EXAMINER'S AMENDMENT

3. An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this Examiner's Amendment was given by Mr. Martin Moynihan in a telephone interview on 11/29/05.

4. Amendments to the title, abstract, specification and claims.

In the title: The phrase "molecular probes" has been deleted and replaced with --antibodies--.

In the abstract of the disclosure:

- The phrase "molecular probes" at line 1 has been deleted and replaced with --antibodies--.
- Each occurrence of the phrase "molecular probe" at the lines 3-4, 5, 7, 8 and 9 has been deleted and replaced with --antibody--.

In the specification:

- With respect to Applicant's amendment filed 1/22/05 of the paragraph starting on page 1 at line 17 of the specification, **the said amended paragraph has been deleted** and replaced with the following:

--This is a continuation of U. S. Patent Application Serial No. 09/322,977, filed June 1, 1999, issued as U.S. Patent No. 6,531,129, which is a divisional of U.S. Patent Application Serial No. 09/071,739, filed May 1, 1998, issued as U.S. Patent No.

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6,177,545, which is a continuation-in-part of U.S. Patent Application Serial No. 08/922,170, filed September 2, 1997, issued as U.S. Patent No. 5,968,822.--

In the claims:

- In claims 26 and 32, --isolated—has been inserted after “An” and before “antibody” at line 1.
- In claims 26 and 32, --or fragment thereof—has been inserted after “antibody” and before “specifically” at line 1.
- In claims 26 and 32, “an” at lines 2 and 3 have been deleted and replaced with —the—after each occurrence of “having” and before “amino acid sequence”.
- In claim 26 and 32, --or—has been added after “SEQ ID NO: 2;” and before “b)” at line 3.
- In claims 26 and 32, “or c) having endoglycosidase activity and being a fragment of a) or b)),” has been deleted at lines 5-6.
- In claims 26 and 32, --or fragment thereof—has been added at line 6 after “wherein said antibody” and before “can”.
- In claims 26 and 32, --specifically—has been added at line 6 after “can” and before “recognize”.
- In claims 27-31 and 33-37, “antibody” at line 1 has been deleted and —isolated antibody or fragment thereof—has been added at line 1 after “The” and before “of claim”.
- In claims 28 and 34, “elicitation of the antibody is through in vivo or in vitro techniques, said antibody having” has been deleted at lines 1-2, and --the said antibody or fragment thereof — has been added after “wherein” at line 1 and before “been prepared” at line 2.

REASONS FOR ALLOWANCE

5. The following is an examiner's statement of reasons for allowance:

a. Claims 26-37 are pending and are allowable.

b. The terminal disclaimer filed 10/4/05 over U.S. Patent Serial No. 6,562,950, U.S. Patent Serial No. 6,177,545 and U.S. Application Serial No. 10/645,659 is acceptable.

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c. The Examiner notes that Kosir *et al* (J. Surg. Res. 67: 98-105, 1997) disclosed in Applicant's specification was not applied as prior art against the instant claims due to Applicant's disclosure on page 10 at line 18 through page 11 at line 21 and page 75, in view of the Declaration of Israel Vlodavsky under 37 CFR 1.132 filed on 6/18/03 in parent application serial no. 09/322,977 on page 3 at the last three paragraphs and that spanning page 4 of the said Declaration, *i.e.*, the "anti-heparanase" antibody taught by Kosir *et al* was prepared against a contaminant, CTAP III, rather than against heparanase.

d. The claimed antibody specifically binding and elicited by heparanase is not taught or suggested by the prior art.

e. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marianne DiBrino whose telephone number is 571-272-0842. The Examiner can normally be reached on Monday, Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Christina Y. Chan, can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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November 29, 2005



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